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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,885	09/09/2003	Michael L. Dobson	DOBS/0001	2624
24945	7590	05/06/2005	EXAMINER	
STREETS & STEELE 13831 NORTHWEST FREEWAY SUITE 355 HOUSTON, TX 77040			HAWKINS, CHERYL N	
		ART UNIT	PAPER NUMBER	
		1734		

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	Applicant(s)
10/657,885	DOBSON, MICHAEL L.
Examiner	Art Unit
Cheryl N. Hawkins	1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 27 January 2005.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-31 is/are rejected.
- 7) Claim(s) 9 and 23 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 9 is objected to because of the following informalities: "actuator" in line 1 of the claim should be changed to --apparatus--. Appropriate correction is required.
2. Claim 23 is objected to because of the following informalities: "actuator" in line 1 of the claim should be changed to --apparatus--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15, 18-20, and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Heaton (US 4,452,663).

As to Claim 15, Heaton discloses an apparatus (Figure 1, wall board taping apparatus 10) for applying tape from a roll (Figure 2, roll 44) to a seam between abutting sheets of wall board (Figure 2, wall board 50) comprising a frame (Figure 1, frame members 12 and 14) for rotatably supporting a roll of tape, the frame having an opening (Figure 1, frame member 16) through which tape may be dispensed from the roll; a roller (Figure 1, press roller 22) carried by the frame adjacent the opening for pressing tape dispensed through the opening from a roll rotatably

supported by the frame against a seam between abutting sheets of wall board; a brake (Figure 1, brake member 48) supported by the frame for applying a braking force to a roll of tape rotatably supported by the frame, thereby preventing tape from being dispensed through the opening from the roll; an elongated handle (Figure 1, handle 20) connected to the frame; and an actuator (Figure 1; trigger 58) connected to the elongated handle for remotely actuating the brake. It is noted that the apparatus of Heaton is capable of applying tape while being free of wall board compound.

As to Claim 18, Heaton discloses an apparatus which includes a shaft (Figure 1, shaft 46) carried by the frame (Figure 1, frame members 12 and 14) for rotatably supporting a roll of tape (Figure 1, roll 44).

As to Claim 19, Heaton discloses an apparatus wherein the frame includes substantially parallel sidewalls (Figure 1, frame members 12 and 14) defining a space within which the shaft (Figure 1, shaft 46) and the tape roll (Figure 2, roll 44) are carried.

As to Claim 20, Heaton discloses an apparatus wherein the space defines a pathway for the tape to move from a roll (Figure 1, roll 44) rotatably supported by the frame to the opening for dispensing (Figure 1, frame member 16).

As to Claim 24, Heaton discloses an apparatus wherein the actuator (Figure 1, trigger 58) comprises a lever pivotally connected to the elongated handle (Figure 1, handle 20) opposite the frame (Figure 1, frame members 12 and 14) and a linkage (Figure 1, cable members 52 and 54) connecting the lever to the brake (Figure 1, brake member 48).

As to Claim 25, Heaton discloses an apparatus wherein the elongated handle (Figure 2, handle 20) is tubular and the linkage (Figure 1, cable members 52 and 54) includes an elongated

link connected to the lever and extending through at least a substantial portion of the elongated handle.

As to Claim 26, Heaton discloses an apparatus wherein the elongated link (Figure 1, cable members 52 and 54) comprises a cable.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-6, 9-12, 15, 23, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) in view of Diaz (US 5,476,571).

As to Claim 1, Heaton discloses an apparatus (Figure 1, wall board taping apparatus 10) for applying a material from a roll (Figure 1, roll 44) to a surface (Figure 2, wall board 50) comprising a frame (Figure 1, frame members 12 and 14) for rotatably supporting a roll of material, the frame (Figure 1, frame member 16) having an opening through which material may be dispensed from the roll; a roller (Figure 1, press roller 22) carried by the frame adjacent the opening for pressing material dispensed through the opening from a roll rotatably supported by the frame against the surface; a brake (Figure 1, brake member 48) supported by the frame for applying a braking force to a roll of material rotatably supported by the frame, thereby preventing material from being dispensed through the opening from the roll; an elongated handle (Figure 1, handle 20) connected to the frame; and an actuator (Figure 1, trigger 58) connected to

the elongated handle for remotely actuating the brake. Heaton does not disclose an apparatus wherein the actuator is separated from the brake by a distance of approximately three feet or more. It is well known and conventional in the tape dispensing art, as disclosed by Diaz (column 5, lines 57-58), to provide a taping apparatus for applying tape to a wall joint with an elongated handle, e.g. a handle being approximately four feet in length, to enable a user to apply tape to an entire standard-height wall joint without utilizing a ladder. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the elongated handle of Heaton to be several feet in length as suggested by Diaz to enable a user to apply tape to an entire standard-height wall joint without utilizing a ladder. It is noted that the apparatus resulting from this modification would include having the actuator separated from the brake by a distance of several feet, i.e. three feet or more.

As to Claim 4, Heaton discloses an apparatus which includes a shaft (Figure 1, shaft 46) carried by the frame (Figure 1, frame members 12 and 14) for rotatably supporting a roll of tape (Figure 1, roll 44).

As to Claim 5, Heaton discloses an apparatus wherein the frame includes substantially parallel sidewalls (Figure 1, frame members 12 and 14) defining a space within which the shaft (Figure 1, shaft 46) and the tape roll (Figure 2, roll 44) are carried.

As to Claim 6, Heaton discloses an apparatus wherein the space defines a pathway for the tape to move from a roll (Figure 1, roll 44) rotatably supported by the frame to the opening for dispensing (Figure 1, frame member 16).

As to Claim 9, Heaton discloses an apparatus wherein the elongated handle (Figure 1, handle 20) is connected to the frame (Figure 1, frame members 12 and 14) at one of its ends and is connected to the actuator (Figure 1, trigger 58) adjacent another of its ends.

As to Claim 10, Heaton discloses an apparatus wherein the actuator (Figure 1, trigger 58) comprises a lever pivotally connected to the elongated handle (Figure 1, handle 20) opposite the frame (Figure 1, frame members 12 and 14) and a linkage (Figure 1, cable members 52 and 54) connecting the lever to the brake (Figure 1, brake member 48).

As to Claim 11, Heaton discloses an apparatus wherein the elongated handle (Figure 2, handle 20) is tubular and the linkage (Figure 1, cable members 52 and 54) includes an elongated link connected to the lever and extending through at least a substantial portion of the elongated handle.

As to Claim 12, Heaton discloses an apparatus wherein the elongated link (Figure 1, cable members 52 and 54) comprises a cable.

As to Claim 15, Heaton discloses an apparatus (Figure 1, wall board taping apparatus 10) for applying tape from a roll (Figure 2, roll 44) to a seam between abutting sheets of wall board (Figure 2, wall board 50) comprising a frame (Figure 1, frame members 12 and 14) for rotatably supporting a roll of tape, the frame having an opening (Figure 1, frame member 16) through which tape may be dispensed from the roll; a roller (Figure 1, press roller 22) carried by the frame adjacent the opening for pressing tape dispensed through the opening from a roll rotatably supported by the frame against a seam between abutting sheets of wall board; a brake (Figure 1, brake member 48) supported by the frame for applying a braking force to a roll of tape rotatably supported by the frame, thereby preventing tape from being dispensed through the opening from

the roll; an elongated handle (Figure 1, handle 20) connected to the frame; and an actuator (Figure 1, trigger 58) connected to the elongated handle for remotely actuating the brake. It is noted that the apparatus of Heaton is capable of applying tape while being free of wall board compound.

As to Claim 23, the references as combined disclose an apparatus wherein the elongated handle is connected to the frame at one of its ends and is connected to the actuator adjacent another of its ends (see Heaton - Figure 1), the elongated handle having a length of three feet or more (see Diaz - column 5, lines 57-58).

As to Claim 29, Heaton discloses a method of applying material from a roll (Figure 2, roll 44) to a surface (Figure 2, wall board 50) comprising the steps of loading a roll of material into a dispensing frame (Figure 1, wall board taping apparatus 10) mounted on an elongated handle (Figure 1, handle 20) and having an opening (Figure 1, frame member 16) and a pressing roller (Figure 1, press roller 22); feeding an end of the material from the roll through the frame opening; using the handle and the pressing roller, pressing the end of the material against the surface; using the handle and pressing roller, moving the frame along the surface to dispense the material from the roll through the frame opening and apply the material over the surface; remotely applying a braking force to the material roll from a location on the handle opposite the frame to prevent material from being dispensed from the roll (column 2, lines 7-12 and 33-52). Heaton does not disclose a method wherein a braking force is remotely applied to the material roll from a location on the handle approximately three feet or more from the frame. It is well known and conventional in the tape dispensing art, as disclosed by Diaz (column 5, lines 57-58), to applying tape to a wall joint with an apparatus having an elongated handle, e.g. a handle being

approximately four feet in length, to enable a user to apply tape to an entire standard-height wall joint without utilizing a ladder. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the elongated handle of Heaton to be several feet in length as suggested by Diaz to enable a user to apply tape to an entire standard-height wall joint without utilizing a ladder. It is noted that the method resulting from this modification would include remotely applying a braking force to the material roll from a location on the handle which is several feet, i.e. three feet or more, from the frame.

As to Claim 31, Heaton discloses a method wherein the material is tape and the surface is a seam between abutting sheets of wallboard (column 2, lines 9-12).

7. Claims 2, 3, 13, 14, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) and Diaz (US 5,476,571) as applied to claim 1 above, and further in view of O'Mara et al. (US 6,540,856).

As to Claim 2, the references as combined (see Heaton) disclose using a knife to cut the tape below the roller (column 2, lines 50-52), but does not disclose an apparatus which includes a cutting member having a cutting edge. The disadvantages of manually using a knife to cut the tape, i.e. risk of injury and the awkwardness of handling the taping apparatus with one hand and the knife with the other, would have been readily apparent to one of ordinary skill in the art.

O'Mara et al. discloses an apparatus (Figure 2, dispenser 11) for applying a material from a roll (Figure 2, roll of tape 17) to a surface which includes a cutting member (Figure 2, cutter bar 51) having a cutting edge, the cutting member being carried by the frame adjacent an opening for cutting material dispensed through the opening from a roll rotatably supported by the frame

(column 3, lines 31-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of the references as combined to include a cutting member having a cutting edge as suggested by O'Mara et al. to provide the device with automated cutting.

As to Claim 3, the references as combined (see O'Mara et al.) disclose an apparatus wherein the cutting member (Figure 2, cutter bar 51) is pivotally mounted to the frame for rotation of the cutting edge into engagement with tape material dispensed through the opening from a roll rotatably supported by the frame (column 3, lines 31-37).

As to Claim 13, the references as combined (see O'Mara et al.) disclose an apparatus wherein the actuator (Figure 1, trigger 63) is connected to the elongated handle for remotely rotating the cutting edge (Figure 2, cutter bar 51) into engagement with the material dispensed through the opening from a roll rotatably supported by the frame (column 4, lines 7-8).

As to Claim 14, the references as combined disclose an apparatus wherein the actuator comprises a lever pivotally connected to the elongated handle opposite the frame and a linkage connecting the lever to the brake (Heaton - Figure 2, trigger 58, cable members 52 and 54, brake member 48) and the cutting member (O'Mara et al. - Figure 1, trigger 63 and Figure 2, electrical switch assembly 61, cutting bar 51).

As to Claim 30, the references as combined (see Heaton) disclose using a knife to cut the tape below the roller (column 2, lines 50-52), but do not disclose a step of remotely applying a cutting force to the material. O'Mara et al. discloses a method of applying material from a roll to a surface which includes a step of remotely applying a cutting force to the material adjacent the

opening from a location on the handle opposite the frame to separate the material applied to the surface from the frame (Figure 2, cutter bar 51; Figure 1, trigger 63; column 4, lines 7-8).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) and Diaz (US 5,476,571) as applied to claim 1 above, and further in view of Shi (US 5,236,540).

As to Claim 7, the references as combined do not disclose an apparatus wherein the frame includes a lip adjacent the opening that is yieldably biased toward the roller. Shi discloses an apparatus for applying a material (Figure 4, tape 93) from a roll to a surface which includes a frame (Figure 4, frame 10) having a lip (Figure 4, panel 42) adjacent an opening that is yieldably biased towards a roller (Figure 4, roller 21) for assuring at least a portion of material fed to the opening from the roll rotatably supported by the frame remains at the opening. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of the references as combined to include a lip adjacent the opening that is yieldably biased toward the roller as suggested by Shi to ensure that the material is retained in a position required for effective dispensing.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) and Diaz (US 5,476,571) as applied to claim 1 above, and further in view of Thompson et al. (US 5,792,310).

As to Claim 8, the references as combined do not disclose an apparatus wherein the brake applies a braking force to a side of a roll of material rotatably supported by the frame. It is well

known and conventional in the tape dispenser art, as disclosed by Thompson et al. (Figure 1, brake element 48), to provide a brake which applies a braking force to a side of a roll of tape rotatably supported by the frame to control the dispensation of the tape. It would have been readily apparent to one of ordinary skill in the art that a braking element which acts on the side of the tape roll is functionally equivalent to a braking element which acts on the tape subsequent to its separation from the roll. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of the references as combined to include a braking element which applies braking force to a side of a roll of material rotatably supported by the frame as suggested by Thompson et al. to control the dispensation of the material; a braking element acting on the side of the tape roll being functionally equivalent to a braking element which acts on the tape subsequent to its separation from the roll.

10. Claims 15-20 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) in view of O'Mara et al. (US 6,540,856).

As to Claim 15, Heaton discloses an apparatus (Figure 1, wall board taping apparatus 10) for applying tape from a roll (Figure 2, roll 44) to a seam between abutting sheets of wall board (Figure 2, wall board 50) comprising a frame (Figure 1, frame members 12 and 14) for rotatably supporting a roll of tape, the frame having an opening (Figure 1, frame member 16) through which tape may be dispensed from the roll; a roller (Figure 1, press roller 22) carried by the frame adjacent the opening for pressing tape dispensed through the opening from a roll rotatably supported by the frame against a seam between abutting sheets of wall board; a brake (Figure 1, brake member 48) supported by the frame for applying a braking force to a roll of tape rotatably

supported by the frame, thereby preventing tape from being dispensed through the opening from the roll; an elongated handle (Figure 1, handle 20) connected to the frame; and an actuator (Figure 1, trigger 58) connected to the elongated handle for remotely actuating the brake. It is noted that the apparatus of Heaton is capable of applying tape while being free of wall board compound.

As to Claim 16, Heaton discloses using a knife to cut the tape below the roller (column 2, lines 50-52), but does not disclose an apparatus which includes a cutting member having a cutting edge. The disadvantages of manually using a knife to cut the tape, i.e. risk of injury and the awkwardness of handling the taping apparatus with one hand and the knife with the other, would have been readily apparent to one of ordinary skill in the art. O'Mara et al. disclose an apparatus (Figure 2, dispenser 11) for applying a material from a roll (Figure 2, roll of tape 17) to a surface which includes a cutting member (Figure 2, cutter bar 51) having a cutting edge, the cutting member being carried by the frame adjacent an opening for cutting material dispensed through the opening from a roll rotatably supported by the frame (column 3, lines 31-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Heaton to include a cutting member having a cutting edge as suggested by O'Mara et al. to provide the device with automated cutting.

As to Claim 17, the references as combined (see O'Mara et al.) disclose an apparatus wherein the cutting member (Figure 2, cutter bar 51) is pivotally mounted to the frame for rotation of the cutting edge into engagement with tape material dispensed through the opening from a roll rotatably supported by the frame (column 3, lines 31-37).

As to Claim 18, Heaton discloses an apparatus which includes a shaft (Figure 1, shaft 46) carried by the frame (Figure 1, frame members 12 and 14) for rotatably supporting a roll of tape (Figure 1, roll 44).

As to Claim 19, Heaton discloses an apparatus wherein the frame includes substantially parallel sidewalls (Figure 1, frame members 12 and 14) defining a space within which the shaft (Figure 1, shaft 46) and the roll (Figure 2, roll 44) are carried.

As to Claim 20, Heaton discloses an apparatus wherein the space defines a pathway for material to move from a roll (Figure 1, roll 44) rotatably supported by the frame to the opening for dispensing (Figure 1, frame member 16).

As to Claim 24, Heaton discloses an apparatus wherein the actuator (Figure 1, trigger 58) comprises a lever pivotally connected to the elongated handle (Figure 1, handle 20) opposite the frame (Figure 1, frame members 12 and 14) and a linkage (Figure 1, cable members 52 and 54) connecting the lever to the brake (Figure 1, brake member 48).

As to Claim 25, Heaton discloses an apparatus wherein the elongated handle (Figure 2, handle 20) is tubular and the linkage (Figure 1, cable members 52 and 54) includes an elongated link connected to the lever and extending through at least a substantial portion of the elongated handle.

As to Claim 26, Heaton discloses an apparatus wherein the elongated link (Figure 1, cable members 52 and 54) comprises a cable.

As to Claim 27, the references as combined (see O'Mara et al.) disclose an apparatus wherein the actuator (Figure 1, trigger 63) is connected to the elongated handle for remotely

rotating the cutting edge (Figure 2, cutter bar 51) into engagement with the material dispensed through the opening from a roll rotatably supported by the frame (column 4, lines 7-8).

As to Claim 28, the references as combined disclose an apparatus wherein the actuator comprises a lever pivotally connected to the elongated handle opposite the frame and a linkage connecting the lever to the brake (Heaton - Figure 2, trigger 58, cable members 52 and 54, brake member 48) and the cutting member (O'Mara et al. - Figure 1, trigger 63 and Figure 2, electrical switch assembly 61, cutting bar 51).

11. Claims 15, 18-21, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) in view of Shi (US 5,236,540).

As to Claim 15, Heaton discloses an apparatus (Figure 1, wall board taping apparatus 10) for applying tape from a roll (Figure 2, roll 44) to a seam between abutting sheets of wall board (Figure 2, wall board 50) comprising a frame (Figure 1, frame members 12 and 14) for rotatably supporting a roll of tape, the frame having an opening (Figure 1, frame member 16) through which tape may be dispensed from the roll; a roller (Figure 1, press roller 22) carried by the frame adjacent the opening for pressing tape dispensed through the opening from a roll rotatably supported by the frame against a seam between abutting sheets of wall board; a brake (Figure 1, brake member 48) supported by the frame for applying a braking force to a roll of tape rotatably supported by the frame, thereby preventing tape from being dispensed through the opening from the roll; an elongated handle (Figure 1, handle 20) connected to the frame; and an actuator (Figure 1, trigger 58) connected to the elongated handle for remotely actuating the brake. It is

noted that the apparatus of Heaton is capable of applying tape while being free of wall board compound.

As to Claim 18, Heaton discloses an apparatus which includes a shaft (Figure 1, shaft 46) carried by the frame (Figure 1, frame members 12 and 14) for rotatably supporting a roll of tape (Figure 1, roll 44).

As to Claim 19, Heaton discloses an apparatus wherein the frame includes substantially parallel sidewalls (Figure 1, frame members 12 and 14) defining a space within which the shaft (Figure 1, shaft 46) and the roll (Figure 2, roll 44) are carried.

As to Claim 20, Heaton discloses an apparatus wherein the space defines a pathway for material to move from a roll (Figure 1, roll 44) rotatably supported by the frame to the opening for dispensing (Figure 1, frame member 16).

As to Claim 21, Heaton does not disclose an apparatus wherein the frame includes a lip adjacent the opening that is yieldably biased toward the roller. Shi discloses an apparatus for applying a material (Figure 4, tape 93) from a roll to a surface which includes a frame (Figure 4, frame 10) having a lip (Figure 4, panel 42) adjacent an opening that is yieldably biased towards a roller (Figure 4, roller 21) for assuring at least a portion of material fed to the opening from the roll rotatably supported by the frame remains at the opening. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Heaton to include a lip adjacent the opening that is yieldably biased toward the roller as suggested by Shi to ensure that the material is retained in a position required for effective dispensing.

As to Claim 24, Heaton discloses an apparatus wherein the actuator (Figure 1, trigger 58) comprises a lever pivotally connected to the elongated handle (Figure 1, handle 20) opposite the

frame (Figure 1, frame members 12 and 14) and a linkage (Figure 1, cable members 52 and 54) connecting the lever to the brake (Figure 1, brake member 48).

As to Claim 25, Heaton discloses an apparatus wherein the elongated handle (Figure 2, handle 20) is tubular and the linkage (Figure 1, cable members 52 and 54) includes an elongated link connected to the lever and extending through at least a substantial portion of the elongated handle.

As to Claim 26, Heaton discloses an apparatus wherein the elongated link (Figure 1, cable members 52 and 54) comprises a cable.

12. Claims 15, 18-20, 22, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton (US 4,452,663) in view of Thompson et al. (US 5,792,310).

As to Claim 15, Heaton discloses an apparatus (Figure 1, wall board taping apparatus 10) for applying tape from a roll (Figure 2, roll 44) to a seam between abutting sheets of wall board (Figure 2, wall board 50) comprising a frame (Figure 1, frame members 12 and 14) for rotatably supporting a roll of tape, the frame having an opening (Figure 1, frame member 16) through which tape may be dispensed from the roll; a roller (Figure 1, press roller 22) carried by the frame adjacent the opening for pressing tape dispensed through the opening from a roll rotatably supported by the frame against a seam between abutting sheets of wall board; a brake (Figure 1, brake member 48) supported by the frame for applying a braking force to a roll of tape rotatably supported by the frame, thereby preventing tape from being dispensed through the opening from the roll; an elongated handle (Figure 1, handle 20) connected to the frame; and an actuator (Figure 1, trigger 58) connected to the elongated handle for remotely actuating the brake.

As to Claim 18, Heaton discloses an apparatus which includes a shaft (Figure 1, shaft 46) carried by the frame (Figure 1, frame members 12 and 14) for rotatably supporting a roll of tape (Figure 1, roll 44).

As to Claim 19, Heaton discloses an apparatus wherein the frame includes substantially parallel sidewalls (Figure 1, frame members 12 and 14) defining a space within which the shaft (Figure 1, shaft 46) and the roll (Figure 2, roll 44) are carried.

As to Claim 20, Heaton discloses an apparatus wherein the space defines a pathway for material to move from a roll (Figure 1, roll 44) rotatably supported by the frame to the opening for dispensing (Figure 1, frame member 16).

As to Claim 22, Heaton does not disclose an apparatus wherein the brake applies a braking force to a side of a roll of material rotatably supported by the frame. It is well known and conventional in the tape dispenser art, as disclosed by Thompson et al. (Figure 1, brake element 48), to provide a brake which applies a braking force to a side of a roll of tape rotatably supported by the frame to control the dispensation of the tape. It would have been readily apparent to one of ordinary skill in the art that a braking element which acts on the side of the tape roll is functionally equivalent to a braking element which acts on the tape subsequent to its separation from the roll. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Heaton to include a braking element which applies braking force to a side of a roll of material rotatably supported by the frame as suggested by Thompson et al. to control the dispensation of the material; a braking element acting on the side of the tape roll being functionally equivalent to a braking element which acts on the tape subsequent to its separation from the roll.

As to Claim 24, Heaton discloses an apparatus wherein the actuator (Figure 1, trigger 58) comprises a lever pivotally connected to the elongated handle (Figure 1, handle 20) opposite the frame (Figure 1, frame members 12 and 14) and a linkage (Figure 1, cable members 52 and 54) connecting the lever to the brake (Figure 1, brake member 48).

As to Claim 25, Heaton discloses an apparatus wherein the elongated handle (Figure 2, handle 20) is tubular and the linkage (Figure 1, cable members 52 and 54) includes an elongated link connected to the lever and extending through at least a substantial portion of the elongated handle.

As to Claim 26, Heaton discloses an apparatus wherein the elongated link (Figure 1, cable members 52 and 54) comprises a cable.

#### ***Response to Arguments***

13. In response to the applicant's arguments that Heaton fails to disclose an elongated handle or the location of an actuator at a position remote from a brake, the examiner notes that the applicant's arguments have been considered but are moot in view of the new grounds of rejection. The newly provided reference of Diaz discloses a taping apparatus for applying tape to a wall joint having an elongated handle which is approximately four feet in length. In light of the newly provided reference of Diaz, the examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the elongated handle of Heaton to be several feet in length as suggested by Diaz to enable a user to apply tape to an entire standard-height wall joint without utilizing a ladder. It is noted that the apparatus resulting

from this modification would include having the actuator separated from the brake by a distance of several feet, i.e. three feet or more.

In response to applicant's argument that Heaton fails to disclose an apparatus which is free of wall board compound, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The examiner asserts that the apparatus of Heaton is capable of applying tape while being free of wall board compound, e.g. applying tape to a wall joint which has wall board compound pre-applied thereon.

In response to the applicant's arguments, the recitation of an apparatus which is "free of wall board compound" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's arguments that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, obviousness is established by combining the teachings of the prior art, i.e. the teachings of Heaton, Diaz, and O'Mara et al., to produce the claim invention where there is some motivation found in the knowledge generally available to one of ordinary skill in the art, i.e. the knowledge that manually using a knife to cut the tape dispensed from an apparatus such as that disclosed by Heaton includes the awkwardness of handling the taping apparatus with one hand and the knife with the other, as well as the risk of injury to the user's hand. Therefore, the examiner asserts that obviousness has been appropriately established.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1734

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl N. Hawkins whose telephone number is (571) 272-1229. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (517) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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April 29, 2005

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AU 1734